

### **REMARKS**

In the Office Action, claims 1-5, 7, 8, 11, 14-17 and 22-29 were rejected, and claims 6, 9, 10, 12, 13, and 18-21 were objected to. Reconsideration and allowance of all pending claims are requested.

### **Rejections Under 35 U.S.C. § 102**

Claims 1-5, 8, 14, 16, 17, 22-24, 26-28 were rejected under 35 U.S.C. § 102 (e) as being anticipated by Obara et al. (U.S. Patent No. 6,870,169, hereinafter "Obara").

A *prima facie* case of anticipation under 35 U.S.C. § 102 requires a showing that each limitation of a claim is found in a single reference, practice or device. *In re Donohue*, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Applicants have carefully reviewed the cited references and respectfully traverse the rejections.

### **Independent claims 1, 16, and 23**

#### **Obara does not disclose, teach or suggest a second scanning system having a second resolution.**

Obara discloses a *single scanning device*, an inspection device 18 for scanning a semiconductor wafer and for identifying defect positions. The system in Obara then uses a review device 19 to conduct measurements of the defects. *See*, Obara, column 6, lines 36-50. However, nowhere does Obara disclose, teach or suggest *a second scanning device* as recited in the independent claims. In addition to no disclosure, teaching or suggestion regarding a second scanning device, the system in Obara utilizes the single high resolution system to take low resolution images and then high resolution images, which is not an optimum use of the scanning system. Additionally, the entire work-flow involving using a single device as against using two distinct devices for distinct purposes will be different. This will include the entire spectrum of activities that involve triggering

of the scanning systems, the time for exposure and completion of scans, and slowing of non-defective components while high resolution scans are made of defective components. The claimed invention is, therefore, not equivalent to Obara's system, and offers distinct advantages over it.

Examiner referred to column 9, lines 36-51 of Obara as teaching a second scanning system. However, in that passage, Obara merely discloses obtaining a high resolution defect image by using *the same scanning system* that is used to obtain the low resolution images. In fact, through this teaching, Obara actually teaches away from the use of two distinct scanning systems as disclosed and claimed by the Applicants.

Thus, Applicants respectfully submit that the independent claims 1, 16, and 23 are not anticipated by Obara. Claims 2-5, 8, 14 depend from claim 1; claims 17 and 22 depend from claim 16; and claims 24, 26-28 depend from claim 23. These dependent claims are similarly allowable.

### **Rejections Under 35 U.S.C. § 103**

Claims 7, 11, 15, 25, 29 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Obara.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill

in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).


Claims 7, 11, 15 depend from claim 1; and claims 25 and 29 depend from claim 23. Irrespective of what Obara teaches or does not teach with respect to these dependent claims, the Applicants respectfully submit that the independent claims 1 and 23 are non-obvious in view of the arguments hereinabove with respect to 102 rejections. Since claims, 1 and 23 are patentable over Obara, the dependent claims, 7, 11, 15 and 25 and 29 respectively, are also deemed allowable.

### **Conclusion**

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: 7/25/2006

  
\_\_\_\_\_  
Patrick S. Yoder  
Reg. No. 37,479  
FLETCHER YODER  
P.O. Box 692289  
Houston, TX 77269-2289  
(281) 970-4545